

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF DEYNET

Appeal No. 1998-0089
Application No. 08/303,115¹

ON BRIEF

Before KRASS, MARTIN, and BARRY, Administrative Patent Judges.
MARTIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-21, all of the pending claims, under 35 U.S.C. § 103. We reverse.

¹ Application for patent filed September 8, 1994.

A. The invention

The invention is a motor-pump unit suitable for use in a motor vehicle anti-lock braking system. Referring to appellant's Figure 1, a pump housing 2 is located between a motor housing 1 and an electronic housing 3. Spacers 6 (Fig. 2) extend axially through the abutting end surfaces of the three housings and carry conducting lines 6.1 and 6.2, which provide an electrical connection between circuit board 3.1 in electronic housing 3 and brush plate 1.2 in motor housing 1 (Spec. at 5, line 21 to p. 6, line 4). Circumferential packings 9 and 9.1 are located between the abutting end walls to protect the conductors from external moisture (Spec. at 6, lines 4-8).

B. The claims

The independent claims are claims 1 and 21, of which claim 1, the broader claim, reads as follows:

A motor-pump unit, comprising:

a pump housing including a first end surface and a second end surface;

a motor housing including an end surface located in front of the first end surface of the pump housing;

an electronic housing including an end surface located in front of the second end surface of the pump housing; and

electrical connecting lines extending through the end surfaces of the pump housing, motor housing and electronic housing and extending through the pump housing between an inside of the motor housing and an inside of the electronic housing.

C. The references and rejections

The examiner's rejections are based on the following U.S. patents:

Iwai et al. (Iwai)	4,619,591	Oct. 28, 1986
Henein et al. (Henein)	5,360,322	Nov. 1, 1994

Claims 1-5, 12, 13, 17, and 20 stand rejected under § 103 for obviousness over Henein.

Claims 6-11, 14-16, 18, 19, 21 stand rejected under § 103 for obviousness over Henein in view of Iwai.

D. The merits of the rejections

Henein shows various embodiments of motor-driven hydraulic pumps. Referring to Figure 1, a housing 1 consisting of several interconnected housing elements contains a motor 2 located between an electronic control apparatus 3 and a hydraulic section or pump 4. This Figure shows an unnumbered line (partly solid and partly dashed) apparently

representing one or more conductors running between motor brushes 11 and control apparatus 3, which is depicted as a printed circuit board.

In neither the Figure 1 embodiment nor the other illustrated embodiments is the hydraulic section (i.e., pump) located between the motor and the electronic control apparatus, as required by claims 1 and 21. Specifically, in the Figure 2 embodiment, the electronic control apparatus 3 is located between motor 2 and hydraulic section 4. In the embodiments of Figures 3 to 6, the motor is located between the control apparatus and the hydraulic section.

The examiner's argument for the obviousness of the subject matter of claims 1-5, 12, 13, 17, and 20 is that Henein

discloses the claimed invention except for the parts' locations. It would have been obvious to . . . relocate the extant parts of Henein's invention since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70 [CCPA 1950]. Note also that it is an obvious matter of design choice to insulate components in an electronic device such as a pump in order to prevent corrosion and electrical short circuits. [Answer at 4.]

We assume that the examiner's reliance on Japikse is based on the fact that it is cited under the heading "C. Rearrangement of Parts" in Manual of Patent Examining Procedure (M.P.E.P.) § 2144.05 at page 2100-106 (7th ed. July 1998, rev. 1, Feb. 2000). However, this M.P.E.P. section further explains

that "[t]he mere fact that a worker in the art could arrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

This is in accord with numerous Federal Circuit decisions, including In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000), which states:

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. See In

re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp., 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). [Emphasis added.]

The examiner has not explained why the artisan would have been motivated to rearrange Henein's disclosed parts to produce the claimed structure. While we agree that it would have been obvious to insulate the components in an electronic device such as a pump in order to prevent corrosion, that consideration does not amount to a suggestion to rearrange the order of Henein's pump, motor, and electronic control apparatus in such a way as to

satisfy claim 1. The rejection of claims 1-5, 12, 13, 17, and 20 based on Henein is therefore reversed.

As the foregoing deficiency in Henein is not remedied by Iwai, the rejection of claims 6-11, 14-16, 18, 19, and 21 based on Henein in view of Iwai is also reversed.

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REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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JOHN C. MARTIN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
LANCE LEONARD BARRY)	
Administrative Patent Judge)	

JCM:lmb

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